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In re Application of
GOLICZ et al
Application No.: 08/962,077
Filing Date: 14 September 1998
Attorney Docket No.: 9534
For: SHEET FEEDING APPARATUS

: DECISION ON
:
: RENEWED PETITION
:
: UNDER 37 CFR 1.181
:

This is in response to applicants' RENEWED PETITION UNDER 37 CFR 1.181 filed 10 May 2000.

BACKGROUND

On 01 April 1997, applicants filed international application No. PCT/US97/05320, which claims a priority date of 01 April 1996 and designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 09 October 1997. The twenty-month deadline for entry into the national stage in the U.S. expired as of midnight of 01 December 1997.

On 31 October 1997, applicants filed in the United States Patent and Trademark Office, *inter alia*, a cover letter, a declaration and power of attorney, a small entity statement, a preliminary amendment, 8 sheets of formal drawings, and a check for \$527. The cover letter states that "[t]his application is a continuation of [PCT/US97/05320]."

On 14 July 1998, the PTO mailed a NOTICE OF INCOMPLETE APPLICATION (Form PTO-1123) indicating that a filing date had not been assigned because the specification was missing.

On 14 September 1998, applicants submitted a TRANSMITTAL OF SPECIFICATION which was accompanied by the entire PCT application for PCT No. PCT/US97/05320. This TRANSMITTAL stated that this "same document was previously transmitted to the USPTO as designated office on behalf of the International Bureau of WIPO".

On 14 September 1998, applicants filed a PETITION RELATING TO FILING DATE pursuant to 37 CFR 1.181. The petition requested that: (1) the above mentioned application be granted a filing date of 31 October 1997 because the application was complete at that time "within the meaning of 35 U.S.C. 371"; (2) the above mentioned application be granted an effective filing date of 01 April 1997 under PCT Article 11(3), 35 U.S.C. 371, and 37 CFR 1.53(f); and (3) a refund of the petition fee because the application was complete as of 31 October 1997. The petition states that "[t]o commence the national stage, 35 U.S.C. 371(c)(2) says that a copy of the international application ought to be filed 'unless . . . already communicated by the International Bureau'."

Between 14 September 1998 and 21 September 1998, applicants received a Filing Receipt (Form PTO-103X) mailed by the PTO indicating the filing date of the above-mentioned application as 31 October 1997 and indicating that the application is a continuation of PCT/US97/05320 filed 01 April 1997.

On 21 September 1998, applicants filed a WITHDRAWAL OF PETITION RELATING TO FILING DATE (PETITION DATED SEPTEMBER 9, 1998) requesting withdrawal of the previously filed petition and a refund of the petition fee. The petition states that the Filing Receipt indicates a filing date of 31 October 1997 which is the date applicants petitioned for. This WITHDRAWAL was accompanied by a copy of the Filing Receipt.

On 04 June 1999, applicants filed a STATUS INQUIRY and a REQUEST FOR REFUND OF PETITION FEE.

On 30 March 2000, the USPTO mailed a decision (1) dismissing applicants' petition under 37 CFR 1.181 filed 14 September 1998, (2) dismissing applicants' request filed 21 September 1998 to withdraw the petition under 37 CFR 1.181, (3) dismissing applicants' request for refund filed 21 September 1998, and (4) vacating the filing receipt received by applicants between 14 September 1998 and 21 September 1998. The decision also indicated that the above-identified application would be treated under 35 U.S.C. 111 and be accorded a filing date of 14 September 1998.

On 10 May 2000, applicants submitted the instant RENEWED PETITION UNDER 37 CFR 1.181 requesting reconsideration of the decision mailed 31 August 2000. Specifically, applicants request that the application be accorded a filing date under 35 U.S.C. 111 of 31 October 1997 and that the declaration filed 31 October 1997 be accepted. Alternatively, applicants argue that the application was properly filed under 35 U.S.C. 371 on 31 October 1997.

On 15 June 2000, applicants submitted a communication noting a typographical error in the renewed petition filed 10 May 2000. The communication requested that "37 CFR 371" and "37 CFR 111" be considered as --35 U.S.C. 371-- and --35 U.S.C. 111--, respectively. The renewed petition has been considered in accordance with this request.

DISCUSSION

Applicants argue that the application should be accorded a filing date under 35 U.S.C. 111 of 31 October 1997 because (1) applicants submitted a cover letter stating that the application was a continuation of PCT/US97/05320 and a declaration identifying the specification executed as PCT/US97/05320, (2) the USPTO received a copy of PCT/US97/05320 on 09 October 1997, and (3) "the filing date of a continued prosecution application is the date on which the request is filed" as per 37 CFR 1.53(d)(2). However, the above-identified application is not a continued prosecution application under 37 CFR 1.53(d)(2). See 37 CFR 1.53(d)(1). Rather, it is a continuation application under 37 CFR 1.53(b).

Applicants also urge that the declaration filed 31 October 1997 properly identifies the specification. This argument is based on the last paragraph of MPEP § 1896 which states that the "specification may be identified in a U.S. national application filed under 35 U.S.C. 111(a) by reference to an attached specification or by reference to the application number and filing date of a specification previously filed in the Office." However, the declaration identifies an international application rather than "a specification previously filed in the Office." Note that the last paragraph of MPEP § 1896 goes on to state that a specification in a national stage application filed under 35 U.S.C. 371 may be identified "in the same manner as applications filed under 35 U.S.C. 111(a) or may identify the specification by reference to the application number and filing date of the international application." By implication then, an international application is not considered a "specification previously filed in the Office."

Applicants also contend, assuming *arguendo* that the above-identified application is not accorded a filing date under 35 U.S.C. 111 of 31 October 1997, that the above-identified application was a proper filing under 35 U.S.C. 371. The previous decision stated:

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

* * *

If there are any conflicting instructions as to which sections of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111.

In the present application, the submission filed 31 October 1997 contained no

indication that the application was being submitted under 35 U.S.C. 371. The cover letter stated that the application was a *continuation* of PCT/US97/05320 indicating that applicants intended to claim benefit under 35 U.S.C. 120. Such benefit cannot be claimed in an application filed under 35 U.S.C. 371. Moreover, Section 371 of the statute was not mentioned in any of the papers filed in this application until the petition filed 14 September 1998. Accordingly, the application will be treated as filed under 35 U.S.C. 111.

Applicants urge that the use of the word "continuation" in the cover letter is "clearly subordinate and outweighed by the prima facie instruction and all the other implied instructions and supporting evidence for a [35 U.S.C.] 371 filing [and that] [t]hus there is no conflicting instruction." The "prima facie instruction" referred to is the declaration filed on 31 October 1997 which identifies a particular international application by PCT Application Number and International filing date. Although this declaration does execute the international application, and thus could be viewed as an instruction to process the application under 35 U.S.C. 371, the cover letter, as discussed above, contains conflicting instructions to process the application under 35 U.S.C. 111(a). Note that the Official Gazette Notice refers to "any conflicting instruction" rather than to a preponderance of the evidence.

The specification filed on 14 September 1998 meets the requirements for granting a filing date for a filing under 35 U.S.C. 111(a). However, the declaration filed 31 October 1997 is defective in that it fails to properly identify the specification to which it is directed, as required under 37 CFR 1.63(a)(2). The declaration identifies the international application, which is improper in an application filed under 35 U.S.C. 111. See MPEP § 1896.

Applicants are not entitled to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter, since this application (Application No. 08/962,077) and the international application (PCT/US97/05320) designating the United States were not copending on 14 September 1998. Applicants may wish to consider filing a petition to revive the international application for the purposes of establishing copendency.

CONCLUSION

For the reasons set forth above, the renewed petition under 37 CFR 1.181 is **DISMISSED**.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Alternatively, applicants may wish to consider filing a petition under 37 CFR 1.137 to revive the international application as being unintentionally abandoned in order to establish.

copendency. In this instance, applicants may either claim 35 U.S.C. 120 benefit in the above-identified application to the PCT application or may instead file another application under 35 U.S.C. 371. Such a petition should include a cover letter entitled "Petition Under 37 CFR 1.137".

The application will be forwarded to Office of Initial Patent Examination for processing as a regular national application under 35 U.S.C. 111(a) and for issuance of a new Filing Receipt with a filing date of **14 September 1998** in accordance with this Decision.



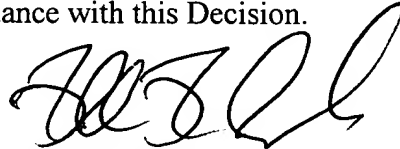
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